



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,886	02/10/2004	Naoto Matsunami	81940.0070	1418
26021	7590	02/23/2006		
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611				
			EXAMINER HEIN, GREGORY P	
			ART UNIT 2188	PAPER NUMBER

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/775,886	Applicant(s) MATSUNAMI ET AL.	
	Examiner Gregory P. Hein	Art Unit 2188	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 - 14 and 26 - 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 - 14 and 26 - 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/7/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the system of claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

2. The information disclosure statement filed 12/28/2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the cited NPL literature on page 3 in rows AR and AT does not list the relevant pages and the cited literature is too voluminous to consider. Additionally, the NPL literature in row AS does not include a date. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession

Art Unit: 2188

of the claimed invention. There does not seem to be support in the specification as originally filed for the amended claimed subject matter. Applicant is requested to point specifically to where in the specification there is support for each of the amended claim elements. Additionally, applicant is requested to submit a statement to be included in the conclusion attesting no new matter has been included in the amendment.

5. All dependent claims are rejected as having the same deficiencies as the claim they depend from.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Pre-Grant Publication 2003/0046270 (Leung et al.)

8. As per claim 8, Leung teaches:

At least one first controller to be coupled to the computer, wherein the first controller is configured to manage a first file system and receives from the computer an access request containing identification information of a file in the first file system (Leung ¶129 lines 7 – 14);

At least one second controller being coupled to the at least one first controller (Leung ¶31 lines 3 – 8 Leung discloses that NAS and SAN systems may be attached to the DMS which would include a secondary controller attached to storage devices.);

A plurality of first disks each being coupled to the at least one second controller, wherein in the plurality of first disks, a first storage region is configured, and on the first storage region, the first file system is configured (Leung ¶28 lines 6 – 7 cite "File server 122 may be configured to manage directories and files systems and Leung ¶29 lines 4 – 6 says this processing may be done by the DMS thus allowing the first controller to manage the file system configured in the first plurality of storage devices.),

Wherein a plurality of policies used for deciding a file storing location are prepared by a plurality of software programs (Leung ¶30 lines 1 – 7);

Wherein the at least one first controller, upon receiving an access request from the computer, is configured to decide according to a property of a file designated by identification information contained in the access request and a policy applied to the file as to which one of the first storage region and the second storage region to store data of the file (Leung ¶30),

When it is decided to store the data of the file in the first storage region, the at least one second controller is configured to store the data of the file in the plurality of first disks (Leung ¶29 lines 1 - 4),

Wherein management information of the file including location information of the file and identification information of a software program, by which the policy applied to the file is prepared, are stored in the first system (Leung ¶30 lines 6 - 7).

9. Per the additional features of claim 8 not addressed here those features of the claim are given no patentable weight. The preamble of the claim makes claim to the first system. The second system and comprising components and all associated features are therefore also given no patentable weight in the present application.

Wherein the at least one first controller is configured to couple to a second system having a third controller, which is configured to manage a second file system and receive an access request containing identification information of a file in the second file system, and a plurality of second disks coupled to the third controller, wherein in the plurality of second disks, a second storage region is configured, and on the second storage region, the second file system is configured, wherein the plurality of first disks and the plurality of second disks have different kinds of interfaces,

When it is decided to migrate the file from the first storage region to the second storage region the at least one first controller is configured to transmit a write request containing another identification information of the file to the second system so that the data of the file is stored in the second storage region, and

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9 – 10, 26 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pre-Grant Publication 2003/0046270 (Leung) in further view of U.S. Pre-Grant Publication 2005/0149528 (Anderson et al).

12. As per claim 26:

Leung does not teach accessing a file using file access information previous to a migration.

Anderson teaches file network referral systems (Anderson ¶11 describes the process by which a client is referred to a different file system to access the requested file.) It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Anderson with Leung since Anderson provides a way address situations wherein the client requests information from a file system not containing the requested data (Anderson ¶11 lines 3 – 6.)

As per claim 27,

Art Unit: 2188

Anderson teaches file network referral systems (Anderson ¶11) and including file identification information on the first file system (Anderson ¶14 lines 6 – 10.)

As per claim 9,

Claim 9 is directed to subject matter carrying no patentable weight and therefore no art is applied.

Response to Arguments

13. Applicant's arguments, see applicants arguments filed 1/26/2006, filed 1/23/2006, with respect to the rejection(s) of claim(s) 1 - 25 under 35 U.S.C. 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of 35 U.S.C. 112 as set forth above.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 2188

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory P. Hein whose telephone number is 571-272-4180. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on 571-272-4210. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mano Padmanabhan
5/20/06

Gregory Hein

MANO PADMANABHAN
SUPERVISORY PATENT EXAMINER

Application/Control Number: 10/775,886

Page 10

Art Unit: 2188

2/9/2006